

DETAILED ACTION

Status of Claims

1. This is a Non-Final office action in reply to the application filed on 7 October 2003.
2. Claims 1-9 are currently pending and has been examined.

Priority

3. Applicant's claim for the benefit of a prior-filed application, Application No. 09/519176, under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: **reference characters 14, 16, 18, 20, 22, 24 and 26**. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Specification

6. The disclosure is objected to because of the following informalities:
7. The abstract have more than 150 words. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.
8. The specification contains an embedded hyperlink and/or other form of browser-executable code on page 13. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. Appropriate correction is required.

Claim Objections

9. Claims 7-9 are objected to because of the following informalities: it appear to be that paragraph numbers [0047], [0048] and [0049] are between claims 7-9. Appropriate correction is required.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1, 3-4 and 8-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
12. As per Claim 1 recites the limitations *said individual, the evaluation, the performance, the group and said questionnaire*, claims 2-4 recites the limitations *said evaluation, the target individual's results and the outcome*, claim 8 recites the limitation *the demographics* and claim 9 recites the limitations *said demographics, the age, the incomes, the sex, the educational levels, the occupations and the geographic residences*. There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 101

13. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
14. Claims 1 – 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)).

A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claim 1 although it recites *personal computer*, *computer network* and *information-provider computer*, the recitation appears to be a nominal recitation. Claims 2-9 inherit the same deficiencies as claim 1 and are therefore rejected for the same reasons as claim 1.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. Claims 1-5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boe et al (US 6,236,975 B1) hereinafter "Boe" in view of Smith, JR. et al (US 2002/0128898 A1) hereinafter "Smith JR" further in view of McGhee et al, **Psychological aspects of excimer laser surgery for myopia: reasons for seeking treatment and patient satisfaction**, *British Journal of Ophthalmology*; October 1996; Vol. 80, Issue 10; pages 874-879, hereinafter "McGhee".

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific

limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim 1:

Boe as shown discloses the following limitations:

- *wherein said survey is conducted over at least one computer network wherein said network connects at least one personal computer associated with said target individual to at least one information-provider computer, the method comprising the steps (see at least Figure 1, which it illustrates a survey system connected to a plurality of personal computers and column 3 lines 44-67 which teaches that "the network 16 may be any interconnection found on any computer network such as a local area network (LAN), a wide area network (WAN), the Internet, or any other communications and data exchange systems created by connecting two or more computers");*
- *a) establishing a communication link between said at least one personal computer associated with said target individual to said at least one information-provider computer over said network (see at least Figure 1, which it illustrates a survey system connected to a plurality of personal computers and column 3 lines 44-67 which teaches that "[c]ommunication lines 20 may be any type of communication link capable of supporting data transfer" where "[c]ommunication lines 20 may be also connected to a plurality of intermediate servers between network 18 and survey system 12, business system 14 and customer system 16");*
- *c) confirming acceptance by said target individual of said contract provided for in step b) (see at least column 4, lines 39-48: which teaches that "[t]he customer then provides to survey system 12 responses to the series of survey questions*

previously chosen by the business” where Boe suggests that it is implicitly disclosed that the customer (e.g., target individual) have accepted some sort of agreement in order to participate and respond the series of survey questions);

- *d) providing said target individual with said survey* (see at least column 21, lines 7-14, which Boe teaches that “submits surveys to customers” where surveys are provided to target individual (e.g., customers));
- *e) receiving answers to said questionnaire from said target individual in response to said survey provided for in step b)* (see at least column 15, lines 30-34, which teaches that “the customer chooses a response to the presented question in step 186, survey system 12 stores the response in matching database 24, as shown in step 188. Survey system 12 also stores data to indicate that the customer has answered this particular question” where by storing the responses, answers are received);
- *and g) generating advertising materials and displaying said advertising materials across said network to said personal computer, said advertising materials being generated based upon said answers received in step e)* (see at least column 7, lines 1-8: “[a]s the customer responds to the survey questions, survey system 12 may update the choice of advertisement by repeating the above process for profiles based on all data as opposed to profiles based on demographic data only. Thus, with each response from a customer, survey system 12 may update the “all data” profile for that particular customer and choose a new advertisement from matching database 24 with a more reliable probability of purchase each time” which Boe teaches that advertisements are generated based on the customer responses);

Boe does not disclose the following limitations however Smith JR as shown does:

- *b) providing a contract to said target individual via said at least one personal computer over said network, said contract providing an offer to provide said target individual with an incentive for completing said survey (see at least page 8 ¶ 0128 and page 9, ¶ 0139: which teaches that “survey responses from network users participating in the survey are captured and inserted into the information repository or storage unit. At step 624, compensation or incentives are managed for network users who complete the survey” which Smith JR suggests that by finishing a survey an incentive or reward is given to the user in order to motivate the user to participate again, which is well known in the art to provide rewards or incentives in exchange for answering surveys. It is implicitly disclosed that an agreement have been made between the user and the survey provider when a survey is completed in order to receive a reward or incentive);*
- *f) providing said target individual with said incentive contracted for in step c) (see at least page 8 ¶ 0128 and page 9, ¶ 0139: which teaches that “survey responses from network users participating in the survey are captured and inserted into the information repository or storage unit. At step 624, compensation or incentives are managed for network users who complete the survey” which Smith JR suggests that by finishing a survey an incentive or reward is given to the user (e.g., target individual) in order to motivate the user to participate again, which is well known in the art to provide rewards or incentives in exchange for answering surveys);*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system and method for profiling customers for targeted marketing of Boe with dynamically assigning a survey to a respondent as taught by Smith JR because it provides “a mechanism that can offer an efficient, fast, and cost-effective solution to qualifying individuals and for inviting those qualified individuals to participate in appropriate and relevant surveys” (Smith JR, see at least page 1, ¶ 0020). Furthermore, provides “a mechanism that can increase the

value of a company's market research by heightening the relevancy for individuals who share their opinions in market research initiatives, and significantly increasing the quality of the conducted research through improved completion rates.” (Smith JR, see at least page 1, ¶ 0021).

The combination of Boe / Smith JR does not specifically disclose the following limitation. However, Boe teaches that the system “allows a business to survey specific customers and to identify ones of such customers that might want to purchase particular products or services” (e.g., medical procedure) where Boe suggests that surveys are custom made and they are created and tailored based on a business particular needs (see at least column 2-3, lines 66-67 and 1-2, respectively). In addition, Smith JR teaches that “[b]y selecting a particular question type button, the client” (e.g., the business) “begins the question definition process” where by using a scale, for example “please indicate how strongly you agree or disagree with the following statement:”, “[t]he client may then enter text to complete the question as desired” which Smith JR suggests that surveys are custom made and they are created and tailored based on a business (e.g., the client) particular needs (see at least page 5, ¶ 0068-0088).

However McGhee as shown does:

- *wherein said survey is directed to the evaluation of the performance of a medical procedure experienced by said individual (see at least page 875, 2nd column Method and page 876, 2nd column Operative Procedure: which teaches that “[a] total of 38 questions were devised which covered six main topics related to patient care, satisfaction, and patient’s reasons for undergoing this form of surgery” where a survey was delivered to 100 patients who evaluated the performance of a medical procedure where “[t]he vast majority of patients noted that their operation was performed professionally”);*
- *said procedure being selected from the group consisting of liposuction, lasik vision correction, and vasectomy performed in an outpatient medical facility by a health care provider on said target individual (see at least page 874, Abstract, Aims and*

2nd column, 1st ¶: McGhee teaches a survey “to determine the reasons patients see excimer laser treatment for myopia” (e.g., eye vision correction) “and to measure levels of patient satisfaction”. In addition, McGhee teaches that “[p]atient satisfaction has been measured in relation to many other forms of medical treatment” (e.g., liposuction, vasectomy) “and has traditionally been seen as a measure of quality of that treatment”. McGhee suggests that surveys for evaluation of performance of a medical treatments or procedures are well known in the art to determine customer satisfaction);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system and method for profiling customers for targeted marketing of Boe and dynamically assigning a survey to a respondent as taught by Smith JR with the survey to determine the reasons patients seek excimer laser treatment of McGhee because surveys are well known in the art to determine customer preferences, therefore surveys about medical treatment procedure helps to conclude that “[s]atisfied patients are more likely to comply with treatment and studies of satisfaction can give valuable information to providers of a service regarding possible improvement in areas such as communication and mode of treatment delivery”. Furthermore, “[c]arefully constructed satisfaction studies are not merely for the purpose of reassuring the practitioner that a specified number of patients are ‘satisfied’ but should rather from the basis for critical analysis and improvement of service”. (McGhee, see at least page 874, 2nd column, 1st ¶).

Claim 2:

The combination of Boe / Smith JR / McGhee teaches the limitations of Claim 1, as explained above. Furthermore, McGhee as shown discloses the following limitations:

- *wherein said evaluation comprises obtaining data regarding the target individual's results with the outcome of said medical procedure (see at least page 877, 1st column, 1st ¶, Table 1 which it illustrates a summary of patients positive and very*

positive responses with regard to questions on long term outcomes and Figure 3, which it illustrates patient's responses with regard to satisfaction with overall outcome. McGhee teaches that data was obtained and evaluated regarding patient results with the outcome of excimer laser treatment);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system and method for profiling customers for targeted marketing of Boe and dynamically assigning a survey to a respondent as taught by Smith JR with the survey to determine the reasons patients seek excimer laser treatment of McGhee because as explained in Claim 1.

Claim 3:

The combination of Boe / Smith JR / McGhee teaches the limitations of Claim 1, as explained above. Furthermore, McGhee as shown discloses the following limitations:

- *wherein said evaluation comprises obtaining data regarding the target individual's satisfaction with the outpatient medical facility within which said procedure was performed* (see at least page 874, 2nd column, 1st and 2nd ¶¶: "when asked specific questions regarding topics such as communication, support from staff" where McGhee teaches that "[a] proved relation exists between patient satisfaction and use of a service, with dissatisfied patients moving from one service provider to another". In addition, McGhee suggests that is well known in the art to obtain data related about patients satisfaction with regard to the medical facilities in order to improve the patients experience and expectative);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system and method for profiling customers for targeted marketing of Boe and dynamically assigning a survey to a respondent as taught by Smith JR with the survey to determine the reasons patients seek excimer laser treatment of McGhee because as explained in Claim 1.

Claim 4:

The combination of Boe / Smith JR / McGhee teaches the limitations of Claim 1, as explained above. Furthermore, McGhee as shown discloses the following limitations:

- *wherein said evaluation comprises obtaining data regarding the target individual's satisfaction with the health care provider responsible for having performed said medical procedure on said target individual* (see at least page 876, 2nd column Preoperative Information and Assessment and Operative Procedure, which McGhee teaches that data was obtained regarding the patient satisfaction toward the health care provider responsible for the excimer laser correction, where “[m]ost patients (95.6%, very positive 94.5%) believed that their questions were answered adequately” and “[t]he vast majority of patients noted that their operation was performed professionally (98.9%, very positive 97.7%) and that they had no difficulty following the surgeon’s instructions” “during the operation”);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system and method for profiling customers for targeted marketing of Boe and dynamically assigning a survey to a respondent as taught by Smith JR with the survey to determine the reasons patients seek excimer laser treatment of McGhee because as explained in Claim 1.

Claim 5:

The combination of Boe / Smith JR / McGhee teaches the limitations of Claim 1, as explained above. Furthermore, Boe as shown discloses the following limitations:

- *a) repeating steps a) through h) such that multiple responses are gathered from a multiplicity of target individuals* (see at least column 21, lines 8-14, which Boe teaches that “an integrated system is provided that prepares customized surveys, characterizes existing and potential customers, submits surveys to customers, stores responses to surveys, allows customers to retrieve product and service

information, allows customers to apply for specific products and services, and prepares reports for businesses to use for targeted marketing” where multiple responses are collected from customers);

- *b) statistically analyzing said multiplicity of responses from said multiplicity of target individuals to derive statistical findings* (see at least Figure 6b and column 18, lines 40-64: which Figure 6b illustrates an exemplary Interest Match report where Boe teaches that “survey system 12 displays the analysis of the data associated with the pre-selected product or service” where “[t]he statistical processing program may then segment the data and predict probabilities of purchase”. Boe suggests that statistical analysis is performed to the data (e.g., multiplicity of responses) associated with a pre-selected product or service);
- *and c) publishing said statistical findings* (see at least column 18, lines 40-44: which teaches that “[o]nce the business representative decides on this option, survey system 12 displays the analysis of the data associated with the pre-selected product or service. This analysis may include probabilities that were determined by using a commercially available statistical processing program” where Boe suggests that the business representative have access to reports (e.g., customer response data, demographic profiles) through survey system where they are available (e.g., published));

Claim 7:

The combination of Boe / Smith JR / McGhee teaches the limitations of Claim 1, as explained above. Furthermore, Boe as shown discloses the following limitations:

- *a) gathering personal data of said target individual and generating a profile for said target individual* (see at least columns 3, lines 23-27: which teaches that “[w]hen a customer accesses the survey, survey system 12 may request demographic information to characterize that customer. This information may include income

level, number of children, education level, gender, age, or any other information” where Boe suggests that user provides their personal information to the survey system and after collecting data, a profile for each customer is created);

- *b) qualifying said target individual using said profile to participate in a survey* (see at least column 3, lines 27-29: which teaches that “[a]fter the customer has been characterized using the information supplied by the customer, survey system 12 may present survey questions to the customer” where Boe suggests that after defining the customer (e.g., target individual) survey system provides survey questions to the customer);

Claim 8:

The combination of Boe / Smith JR / McGhee teaches the limitations of Claim 5, as explained above. Furthermore, Boe as shown discloses the following limitations:

- *wherein said step of statistically analyzing said multiplicity of responses from said multiplicity of target individuals to derive statistical findings further comprises deriving statistical findings based upon the demographics of said target individuals, and said step of publishing said statistical findings further comprises publishing said statistical findings based upon said demographics of said target individuals* (see at least Figure 6b which it illustrates "Results based on All Data", "Profile Description" which shows demographics statistical findings for each profile and column 18, lines 40-54: which teaches that “[o]nce the business representative decides on this option, survey system 12 displays the analysis of the data associated with the pre-selected product or service. This analysis may include probabilities that were determined by using a commercially available statistical processing program” where Boe suggests that the business representative have access to reports (e.g., customer response data, customer demographic profiles) through survey system where they are available (e.g., published));

Claim 9:

The combination of Boe / Smith JR / McGhee teaches the limitations of Claim 8, as explained above. Furthermore, Boe as shown discloses the following limitations:

- *wherein said demographics of said target individuals are selected from the group consisting of the age of said target individuals, the incomes of said target individuals, the sex of target individuals, the educational levels of said target individuals, the occupations of said target individuals, and the geographic residences of said target individuals (see at least column 3, lines 23-27: which teaches that “[w]hen a customer accesses the survey, survey system 12 may request demographic information to characterize that customer. This information may include income level, number of children, education level, gender, age, or any other information” (e.g., occupation and geographic residences));*

18. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Boe / Smith JR / McGhee in view of www.cdc.gov, Centers for Disease Control and Prevention Home Page, <http://web.archive.org/web/19981202185954/http://www.cdc.gov/>; 1998, hereinafter “CDC”.

Claim 6:

The combination of Boe / Smith JR / McGhee teaches the limitations of Claim 5, as explained above. The combination of Boe / Smith JR / McGhee does not disclose the following limitation however, CDC as shown does:

- *wherein said statistical findings are published via a website accessible over a global communications network (see at least Centers for Disease Control and Prevention Home Page: Data & Statistics; CDC Scientific Data, Surveillance, Health Statistics, and Laboratory Information: Health Statistics; Welcome to the National Center of Health Statistics which teaches “Express Links to Surveys and Data Collection Systems” and National Health Interview Survey: Data analysis and Publications, which teaches statistical findings available through CDC web site);*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system and method for profiling customers for targeted marketing of Boe, dynamically assigning a survey to a respondent as taught by Smith JR, the survey to determine the reasons patients seek excimer laser treatment of McGhee with CDC online availability for health related surveys and statistical findings because CDC web site provides access for statistical findings analysis and results, therefore it helps to inform patients about current medical procedures, might influence future research for improvement of medical procedures and services and since the information is available and accessible, it prevent duplication of effort.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- Smolen (US 5,915,243) discloses a method and apparatus for delivering consumer promotions.
 - Hamlin et al (US 6,477,504 B1) discloses a method and apparatus for automating the conduct of surveys over a network system.
 - Pinsley et al (US 6,070,145 B1) discloses a respondent selection method for network-based survey.
 - Schulze, Jr. (US 6,233,564 B1) discloses a merchandising using consumer information from surveys.
 - Skriver et al, **Conventional or Li vasectomy: a questionnaire study**, *British Journal of Urology*, 1997. Vol. 79, pp. 596-598.
 - Steinert et al, **Surgical correction of moderate myopia: Which method should you choose?** II. PRK and LASIK are the treatments of choice. Survey of Ophthalmology, Volume 43, Issue 2, pp. 157 – 179.
 - Short et al, **Reduction Mammoplasty: A Safe and Effective Outpatient Procedure**, *Aesthetic Plastic Surgery*, Volume 20, Number 6 / November, 1996, pp. 513-518.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nadja Chong** whose telephone number is **571.270.3939**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **BETH VAN DOREN** can be reached at **571.272.6737**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

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/Nadja Chong/

Examiner, Art Unit 3623

6 June 2008

/C. Michelle Tarae/
Primary Examiner, Art Unit 3623